REMARKS

In the Office Action dated February 12, 2004, the Examiner rejected claims 1, 3-6, 9-11, 13-16, 19-21, 23-26, 29-31, 33-36, and 39-40 under 35 U.S.C. § 103(a) as unpatentable over Templin et al. (U.S. Patent No. 5,781,550) in view of Aviani, Jr. et al. (U.S. Patent No. 6,532,493); rejected claims 2, 8, 12, 18, 22, 28, 32, and 38 as unpatentable over Templin et al. in view of Aviani, Jr. et al., and further in view of Coile et al. (U.S. Patent No. 6,473,406); allowed claims 41-46, 51-56, 58-66, 68-76, and 78-80; and objected to claims 7, 17, 27, and 37 as dependent upon a rejected base claim, but indicated that these claims would be allowed if rewritten in independent form including all of the recitations of the base claim and any intervening claims.

By this amendment Applicants have amended claims 1, 7, 11, 17, 21, 27, 31, and 37 to correct minor typographical errors. Claims 1-46, 48-56, 58-66, 68-76, and 78-80 remain pending in this case. Applicants acknowledge with appreciation that claims 41-46, 51-56, 58-66, 68-76, and 78-80 have been allowed. The Examiner has also indicated that claims 7, 17, 27, and 37 are "allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims." Office Action ¶ 11. Applicants appreciate the Examiner's indication of allowable subject matter, but for the reasons discussed below, believe independent claims 1, 11, 21, and 31 are allowable over the cited prior art without further amendment. Accordingly, Applicants also respectfully request that the rejection of claims 1-6, 8-16, 18-26, 28-36, and 38-40 under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

I. Claim Rejections Under 35 U.S.C. § 103(a)

The rejection of claims 1-6, 8-16, 18-26, 28-36, and 38-40 under 35 U.S.C. § 103(a) is respectfully traversed for the following reasons.

To establish a prima facie case of obviousness, three basic criteria must be met. First, the prior art reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed., rev. Feb. 2003). Second, there must be some suggestion or motivation in the references themselves to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143. Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02. Moreover, each of these requirements must "be found in the prior art, and not based on applicant's disclosure." M.P.E.P. § 2143.

A. The Rejection of Claims 1, 3-6, 9-11, 13-16, 19-21, 23-26, 29-31, 33-36, and 39-40

Regarding claims 1, 11, 21, and 31, the Examiner admits that Templin et al. "may be silent or deficient" as to "determining a destination address corresponding to the destination based on the client address." See Office Action ¶ 8, at 1. Nonetheless, the Examiner alleges that under a broad interpretation of the word "determine," Templin et al. teaches "determining a destination address corresponding to the destination based on the client address." See Office Action ¶ 8, at 1-2. Furthermore, the Examiner alleges that even if Templin et al. does not teach "determining a destination address corresponding to the destination based on the client address," Aviani, Jr. et al. does. See Office Action ¶ 8, at 2. Applicants respectfully disagree for the following reasons.

Contrary to the Examiner's allegations, neither Templin et al. nor Aviani, Jr. et al. teaches or suggests "determining a destination address corresponding to the

destination based on the client address." Instead, <u>Templin et al.</u> and <u>Aviani, Jr. et al.</u> at best disclose determining a destination address based on a transferred packet. For example, <u>Templin et al.</u> discloses a gateway that facilitates transparent connections between trusted and untrusted hosts. <u>See Templin et al.</u>, Abstract. The gateway intercepts packets intended for an untrusted host and connects to the untrusted host itself, thus keeping the trusted host secure. <u>Id.</u>, col. 8, lines 38-47. In turn, when the gateway receives a packet from the untrusted host, it generates a new packet directed to the trusted host. <u>Id.</u> The packet sent to the trusted host includes the address of the untrusted host, so the trusted host is "spoofed" into believing it connected directly with the untrusted host while still remaining secure. <u>Id.</u>, col. 8, lines 49-54.

Applicants respectfully submit that the Examiner has misunderstood the teachings of <u>Templin et al.</u> The Examiner alleges that in <u>Templin et al.</u>, "the determined destination is based on the client packet/address." Office Action ¶ 8, at 4. This statement is incorrect. The gateway disclosed in <u>Templin et al.</u> does not determine a destination address *based on the client address*. Instead, the gateway in <u>Templin et al.</u> receives the address of the untrusted host (as part of the packet from the trusted host. <u>Templin et al.</u>, col. 7, lines 23-28. Accordingly, at best, the gateway in <u>Templin et al.</u> "determines" the address of untrusted host from the "client" *packet*, not any "client" *address*.

Although <u>Templin et al.</u> also discloses that the addresses of the trusted host and the untrusted host are stored in a control block (<u>id.</u>), the reference does not teach or suggest that the gateway ever has to "determine" the address of the untrusted host based on the address of the trusted host. Although the gateway can use the control

block entries to generate packets to the trusted host that appear to be from the

untrusted host (id., col. 9, lines 4-12), the gateway never uses the control block to

determine the address of the untrusted host. All the packets transferred in Templin et

al. contain the address of the untrusted host. Therefore, there is never a need to

determine a destination address *based on the client address*.

Aviani, Jr. et al. is similarly deficient. Aviani, Jr. et al. discloses a process of

encapsulating packets sent from a source to a destination and re-routing the packets to

selected network caches. See Aviani, Jr. et al., col. 5, lines 38-47. The network cache

in Aviani, Jr. et al. determines whether the requested information is stored locally in the

cache, and if not, makes its own request to the specified destination. See id., col. 5,

lines 53-62. Similar to Templin et al., however, both the packets sent by the client and

the packets sent by the cache in Aviani, Jr. et al. always specify the destination

address. See id., col. 5, lines 34-37 & lines 57-60. Therefore, the cache in Aviani, Jr. et

al. does not determine a destination address corresponding to the destination *based on

the client address*. Instead, as in Templin et al., the cache in Aviani, Jr. et al.

determines the destination address based on the transferred packets.

The Examiner points to a portion of Aviani, Jr. et al. that discloses the handling of

requests specifying a destination platform that requires user authentication through use

of a bypass list. See id., col. 6, line 24 to col. 7, line 16; Office Action ¶ 8, at 5.

Requests specifying a destination platform that requires user authentication will never

be stored in the local cache because user authentication is required in order to access

the destination platform. See id., col. 6, lines 38-41. Therefore, there is no need to

search the local cache for requests specifying destination platforms that require user authentication, because they will never be found.

Contrary to the Examiner's allegation, Aviani, Jr. et al. does not teach or suggest "determining a destination address corresponding to the destination based on the client address." Although the bypass list contains client/server pairs (i.e. source and destination addresses), the system does not use the list to determine a destination address based on the client address. Instead, the bypass list only identifies client/server pairs that should be allowed to pass through the caching system without determining whether the requested information is in the cache. Aviani, Jr. et al., col. 7, lines 1-4. Thus, when a client request contains a particular source and destination address that corresponds to a client/server pair in the bypass list, the cache will not be searched for the data associated with that request. Id.

As with the control blocks in Templin et al., the mere fact that a source and destination address correspond to one another does not mean that the destination address is determined based on the source address. Even though a destination address may correspond to a particular source address, when the destination address is always included in the transferred packets, as in Aviani, Jr. et al. and Templin et al., the destination address is determined based on the *packets*, not the client *address*. Accordingly, contrary to the Examiner's allegation, neither Aviani, Jr. et al. nor Templin et al., either alone or in combination, teach or suggest "determining a destination address corresponding to the destination based on the client address." See Office Action ¶ 8, and 4-6.

Moreover, even if the cited references taught "determining a destination address corresponding to the destination based on the client address," as the Examiner alleges, which they do not, the Examiner failed to provide a motivation to combine the two references. The Examiner stated that "it would have been obvious to one skilled in the art prior to [A]pplicant's invention to include determining a destination address corresponding to the destination based on the client [address]." Office Action ¶ 8, at 5. This statement, however, is insufficient to establish a prima facie case of obviousness. First, it is established that "[t]he level of skill in the art cannot be relied upon to provide the suggestion to combine references." M.P.E.P. § 2143.01, at 2100-125 (citing Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308 (Fed. Cir. 1999)). Moreover, "[a]lthough a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.'" Id. § 2143.01, at 2100-126 (quoting In re Mills, 916 F.2d 680, 682 (Fed. Cir. 1992)) (emphasis added). There is no such suggestion in Templin et al. or Aviani, Jr. et al.

The Examiner alleges that "one would be motivated to determine an address based on whether a previous connection/session is established," and that "[t]he suggestion or motivation for doing so would have been whether there is information already found in the cache. Office Action ¶ 8, at 5. Even if this allegation were true, which Applicants do not concede, this would not motivate one to combine Aviani, Jr. et al. with Templin et al. Determining an address based on whether a previous connection/session is established is irrelevant to Templin et al., and the system disclosed in Templin et al. does not, and would not, use a cache. While Aviani, Jr. et al. involves a caching system, Templin et al. involves a "spoofing" system that uses a

trusted gateway. If an artisan found deficiencies with the trusted gateway system in Templin et al., they would not be motivated to turn to a caching system like that in Aviani, Jr. et al. to correct those deficiencies, because the two systems are unrelated.

For at least the foregoing reasons, the rejection of claims 1, 11, 21, and 31 is unsupported by the cited art. Applicants therefore respectfully request that the rejection of claims 1, 11, 21, and 31 under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

Claims 3-6 and 9-10; 13-16 and 19-20; 23-26 and 29-30; and 33-36 and 39-40 depend upon allowable claims 1, 11, 21, and 31, respectively. As explained above, the rejection of claims 1, 11, 21, and 31 is unsupported by the cited art. Accordingly, the rejection of claims 3-6, 9-10, 13-16, 19-20, 23-26, 29-30, 33-36, and 39-40 is likewise unsupported by the cited art for at least the reasons given with respect to claims 1, 11, 21, and 31. Applicants therefore respectfully request that the rejection of claims 3-6, 9-10, 13-16, 19-20, 23-26, 29-30, 33-36, and 39-40 under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

B.   The Rejection of Claims 2, 8, 12, 18, 22, 28, 32, and 38

Claims 2 and 8; 12 and 18; 22 and 28; and 32 and 38 depend upon allowable claims 1, 11, 21, and 31, respectively. As explained above, the rejection of claims 1, 11, 21, and 31 is unsupported by the cited art because, contrary to the Examiner's allegation, the cited references fail to teach or suggest "determining a destination address corresponding to the destination based on the client address." Accordingly, the rejection of claims 2, 8, 12, 18, 22, 28, 32, and 38 is likewise unsupported by the cited art for at least the reasons given with respect to claims 1, 11, 21, and 31. Moreover

Coile et al. fails to make up for the deficiencies of Templin et al. and Aviani, Jr. et al. in that Coile et al. also fails to teach or suggest "determining a destination address corresponding to the destination based on the client address." Accordingly, for at least the foregoing reasons, the rejection of claims 2, 8, 12, 18, 22, 28, 32, and 38 is unsupported by the cited art. Applicants therefore respectfully request that the rejection of claims 2, 8, 12, 18, 22, 28, 32, and 38 under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

II. Conclusion

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-40 in condition for allowance. Applicants submit that the proposed amendments of claims 1, 7, 11, 17, 21, 27, 31, and 37 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: May 11, 2004   By: _Reg 24, 014_

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